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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,019	12/11/2003	Jun Ozaki	035576/270591	2349

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EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,019	OZAKI, JUN	
	Examiner	Art Unit	
	Rosemary E. Ashton	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/04, 12/11/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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22

Art Unit: 1752

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-282654 in view of JP 2003-292496 (see its CAplus abstract DN 139:292355) or Yamaguchi (CAplus abstract DN 132:293809) and Toyoda et al US patent application publication no. 2004/0175655.

As shown in the Derwent abstract JP 282654 teaches an image forming composition comprising an acid generating compound, a polymer having one phenolic group with a molecular weight of 1200, an alkali soluble resin, an infrared absorbing agent and a crosslinking agent.

It does not teach the crosslinking agent is a silane coupling agent meeting the limitations of formula 1 and 2 in the instant application.

JP 292496 teaches the silane coupling agents meeting the limitations of formula 1 and formula 2 in the instant application. As shown in the CAplus abstracts of JP 2003-292496 (139:292355) the compounds having formula 1 have a dimethoxy-nitro-phenyl group, G1 is O, R3 is (CH₂)_m, m is 3,6, X1 is trimethoxysilyl or triethoxysilyl (abstracts A and E) When R3 is (CH₂)_m, m is 4, G1 is COO and X1 is trimethoxysilyl (abstract D). The compounds having formula 2 have a nitro-phenyl group, G2 is COO, R5 is (CH₂)_m, m is 4, R4 is CH₃, X2 is chlorodimethylsilyl or trichlorosilyl (abstracts B and C).

Yamaguchi teaches the silane coupling agents meeting the limitations of formula 2 in the instant application. As shown in the CAplus abstract (132:293809) the compounds having formula 2 have a nitro-phenyl group, G2 is COO, R5 is (CH₂)_m, m is 4, X2 is trimethoxysilyl.

Toyoda et al teaches a composition comprising a silane coupling agent as a crosslinking agent. The silane coupling agent is used for the purpose of increasing the adhesiveness of the composition (sec. 56).

Art Unit: 1752

As shown above, the primary reference JP 282654 teaches the claimed reagents in an image forming composition, however, it does not teach the claimed silane coupling compounds having formula 1 or formula 2 are in the composition.

It would have been obvious to one of ordinary skill in the art to use the silane coupling agents taught in JP 2003-292496 (CAplus abstract DN 139:29235) or the silane coupling agents taught in with a Yamaguchi with a reasonable expectation of obtaining a composition having improved adhesiveness because Toyoda teaches that when silane coupling agents are used as crosslinking agents the composition has increased adhesiveness.

Allowable Subject Matter

3. Claims 7,8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the phenolic polymer is one of the polymers in claim 8 or a lithographic printing as in claim 9.

5. Claims 9,10 are allowed.

6. The following is an examiner's statement of reasons for allowance: No prior art was found having the polymer compounds of formulas I or II.

Citation of Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To avoid cumulative rejections the examiner did not apply JP 080481 which teaches silane coupling agents which are the same compounds in JP 292496 (abstracts B and C).

Art Unit: 1752

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 571-272-1326. The examiner can normally be reached on Mon-Fri, 11:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rosemary E. Ashton
Primary Examiner
Art Unit 1752

March 20, 2005

ROSEMARY ASHTON
PRIMARY EXAMINER